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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,055	06/24/2003	Fred Harrison	9052.01	7631

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EXAMINER	
ROANE, AARON F	

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/602,055	HARRISON, FRED	
	Examiner	Art Unit	
	Aaron Roane	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *12-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/24/2003*.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *200404261* .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

I. Claims 1-11, drawn to stone therapy apparatus, classified in class 607, subclass 108.

II. Claims 12-20, drawn to method of manufacturing a stone therapy apparatus, classified in class 607, subclass 96.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the stone therapy apparatus can be comprised from natural stones opposed to a mold stone mixture.

During a telephone conversation with Dolph Torrence on 4/27/2004 a provisional election was made with traverse to prosecute the invention of I, claims 1-11. Affirmation of this election must

be made by applicant in replying to this Office action. Claims 12-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claim 3 is objected to because of the following informalities:

Claim 3 recites the limitation "the mechanism of attachment" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Herbranson (USPN 5,848,981).

Regarding claims 1 and 9, Herbranson discloses a thermal device comprising an elongate flexible member (42) and a plurality of stones (49) connected to each other via the elongate flexible member, see col. 3-8 and figures 7-15. Furthermore, it should be noted that although the device and stones are used in a cooling therapeutic manner, the stones inherently have good thermal capacity and therefore could easily serve as heating means.

Regarding claim 3, Herbranson discloses the claimed invention. Claim 3 is directed to an apparatus however method of manufacturing detailed in the claim. The method of manufacturing carries little to almost no weight when considering an apparatus claim.

Regarding claims 5 and 10, the device disclosed by Herbranson is capable of being secured about the shoulder by placing it around one shoulder and under the armpit of that same shoulder. The recitation that the apparatus/device is a shoulder hot stone therapy device is interpreted as intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claims 6 and 8, the device disclosed by Herbranson is capable of being secured about the neck and therefore part of the spine. The recitation that the apparatus/device is a neck or spine hot stone therapy device is interpreted as intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lee (USPN 6,412,303 B1).

Regarding claims 1, Lee discloses a necklace comprising an elongate flexible member (120) and a plurality of stones (122, 124, 126, 128, etc.) connected to each other via the elongate flexible member, see col. 1-4 and figures 75 and 6. Furthermore, it should be noted that although the device and stones are used simply as jewelry, the stones inherently have thermal capacity and therefore could easily serve as heating means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbranson (USPN 5,848,981) in view of design choice.

Regarding claims 2 and 11, Herbranson discloses the claimed invention except for the natural river stones. At the time of the invention, it would have been an obvious matter of design choice to one of ordinary skill in the art to use any type of stone/rock with a good heat capacity because Applicant has not disclosed natural river stones provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any type of stone/rock with a good heat capacity because it will provide the necessary heating/cooling capabilities.

Regarding claim 7, Herbranson discloses the claimed invention. However, Herbranson is silent as to whether or not the device is capable of being used on the hip. At the time of the invention, it would have been an obvious matter of design choice to one of ordinary skill in the art to provide the device with an elongate member longer than that disclosed by Herbranson, so that the device could be used to surround different body parts having larger diameters in order to provide those larger diametered body parts with thermal therapy.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herbranson (USPN 5,848,981) in view of Mochizuki (USPN 5,007,252) and Chia et al. (USPN 6,6229,434 B2).

Regarding claim 4, Lee discloses the claimed invention except for the at least one elongate flexible member forming a duplex arrangement. It is very well known in the art to provide necklaces (and bracelets) with two elongate flexible members in order to have more than one strand of stones such that the two strands are parallel and form a duplex arrangement. Both Mochizuki (see col. 3-6 and figures 17, 19 and 23) and Chia et al. (see col.6-10 and figures 32 and 33) disclose embodiments wherein two strands of jewels (interpreted as stones) are arranged parallel to each other forming a duplex arrangement

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (703) 305-7377. The examiner can normally be reached on 9am - 5pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. A.R.
April 28, 2004

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER